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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/737,376	12/14/2000	Garret Swart	P4701	1801

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EXAMINER

SMITH, JEFFREY A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 08/01/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,376

Applicant(s)

SWART ET AL.

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

The drawings received on 14 December 2000 are approved.

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-37 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The claims are described in terms of a data entity and what they "[describe]". The recitations in this manner are not considered to define tangible subject matter which moves to define an article or structure contemplated by 35 USC 101. The

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language does not move to set forth a computer readable medium, for example, which comprises computer readable instructions that interact and cooperate in such a way as to provide a concrete, tangible, and useful output. The nominal recitation of a "database" or "control system" or "server", being old and necessary antecedent structure, does not serve to convert that which is otherwise non-statutory subject matter into statutory subject matter.

Regarding claims 21-27, in addition to failing to define tangible, concrete, and useful subject matter, these claims recite an ambiguous statutory class of invention which does not serve to reasonably identify whether it encompasses a manufacture or a method for its use.

Regarding method claims 15-20, these claims are considered non-statutory since the method steps do not move to create or form or make any tangible, concrete, and useful article. The steps do not actively serve to assemble or construct a data "entity" which otherwise constitutes a manufacture contemplated by 35 USC 101.

Regarding claim 31, the recitation of a computer readable medium storing computer instructions that handle data entity having a particular format, and absent any recitation of the association and interaction between elements of the data entity

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and the medium is not considered statutory subject matter as contemplated by 35 USC 101. The medium, as recited, produces no tangible, concrete, and useful output.

Regarding claims 32-37, a method of representing a database entity provides no tangible, concrete, and useful result. The method, as recited, merely presents a listing of otherwise disassociated concepts which do not interact in forming either a method or manufacture contemplated by 35 USC 101. Moreover, the claim sets forth an ambiguous statutory class of invention which does not serve to reasonably identify whether it encompasses a method of manufacture or use or whether it encompasses a manufacture itself.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-29, and 31-37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of claim 21 is unclear since an attempt is made to further limit the database by method steps. Such attempt gives rise to a hybrid claim which creates ambiguity and causes the metes and bounds of the claim to be unclear. The ambiguity is furthered by the inconsistency of the preambles of dependent claims which are directed to methods. See below.

The preambles of claims 22-29 are not commensurate with preambles of respective claims from which they depend. For example, the preamble of claim 21 recites a database while the preambles of dependent claims recite a method. A similar problem exists in claims 28 and 29.

The scope of claims 32-37 is unclear. Claim 32 ambiguously recites "representing a database entity". It is not clear in what manner the entity is represented. One of ordinary skill in the art is not apprised of the scope of the claim in such reasonable sense as to avoid infringement of these claims.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -
(e) the invention was described in-

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(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 1, 2, 4-6, 8-11, 15, 16, 18, 19, 21-24, and 28-37 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLorme et al. (U.S. Patent No. 5,948,040).

DeLorme et al. discloses a system and methods for user interactive reservation of services via the Internet (col. 1, lines 28-46). Disclosed are indications of services, providers, locations, temporals, etc...(see example at col. 28, line 64-col. 29, line 9) arranged so as to allow the user to locate and select services according to that user's desire (col. 8, line 23-col. 9, lines 18). Reservables may be located via "browsing" or searching techniques (col. 20, lines 7-15). A user may be directed to services via vertical classifications of related services (col. 16, line 60-col. 17, line 7). Geographic regions are employed to constrain presented services (see example at col. 40, line 62-col. 41, line 5). Users and providers are identified (col. 64, lines 11-14) and engagement is made with a selected provider contingent upon prescribed criterion such as

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service executable times, dates, locations, participants, etc...(col. 67, line 29-col. 68, line 6). Databases, servers, computer readable medium, and control systems are employed.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 7, 12-14, 17, 20, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over DeLorme et al. (U.S. Patent No. 5,948,040) in view of Conklin et al. (U.S. Patent No. 6,141,653).

DeLorme et al. discloses that their system may provide service online by means of an Internet site (col. 14, lines 43-47). Such embodiment may be implemented utilizing distributed applications, "agents" or online "applets" developed in Java, or equivalent computer languages (col. 14, lines 47-52). DeLorme

et al. does not specifically identify employing XML (Extensible Markup Language) expressions.

Conlin et al., however, teaches the equivalence of computer languages including Java and XML (col. 20, lines 41-47). Such languages are taught by Conlin et al. as being employed in a manner similar to that of DeLorme et al. (i.e. creating dynamic text for transmission to a user over the Internet for ultimate display) (col. 21, lines 32-38).

It would have been obvious to one of ordinary skill in the art to have provided the invention disclosed by DeLorme et al. to have included the employment of XML (as taught by Conlin et al.) because of XML's emergence as an Internet standard and because of XML's recognized equivalence to computer languages already disclosed by DeLorme et al. (e.g. Java) for identical purposes already clearly established by DeLorme et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Japanese Patent No. JP360168265A discloses computer implemented reservation of commodities. A list of commodities selected by a user is transmitted to a central location and the

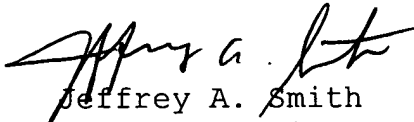
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commodity is reserved. A reservation voucher is issued. See English abstract.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-308-3691 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.


Jeffrey A. Smith
Primary Examiner
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jas
July 27, 2002